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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 10/033,143 | 10/26/2001 | Holger Warth | Mo-6716 LeA 34,676 | 1812 |
| 157 | 7590 | 03/29/2005 | EXAMINER | |
| BAYER MATERIAL SCIENCE LLC | | | YOON, TAE H | |
| 100 BAYER ROAD | | | ART UNIT | |
| PITTSBURGH, PA 15205 | | | PAPER NUMBER | |
| | | | 1714 | |

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------|--------------------------------------|------------------------------------|--|
| Advisory Action | Application No. 10/033,143 | Applicant(s) WARTH ET AL | |
| | Examiner Tae H. Yoon | Art Unit 1714 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 2 months from the ~~mailing date of the final rejection~~ *Notice of Appeal*.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 07 March 2005. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-13.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Tae H. Yoon
Primary Examiner
Art Unit: 1714

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Attachment to Advisory Action

With respect to the table 1, see example 1 wherein "Example 1 (first line) part by wt. --- (second to fifth line)" is recited, and compare with example 2 wherein "Example 2 (first line) 5 part by wt. --- (second to fifth line)" is recited.

Amendment is denied of entry since it raises new issues that would require further consideration and search for following reasons;

1. The recited "hydrocarbon" in claim 4 lacks an antecedent basis in claim 1.
2. Claim 7 depends on cancelled claim 6.
3. The recited "polycarbonates of claim 8 and "vinyl (co)polymers and polyalkyleneterephthlate" of claim 9 are already recited in claim 1.
4. The recited "polybutene and polyisobutene with a particular Mw" of claim 1 is new limitation.
5. The combined limitation of the additive with a particular limitation and polymeric component is new.

Applicant's argument is based on the Amendment being denied of entry, and the examiner believes that no response by the examiner is needed. However, the examiner adds following comments;

1. Applicant asserts that no example of Katayama et al discloses the use of AES resin, but the disclosure is not limited to working examples. See *In re Mills*, 477 F2d 649, 176

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USPQ 196 (CCPA 1972); Reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples.

2. Secondary references are cited to show the art well known processing aids.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tae H Yoon
Primary Examiner
Art Unit 1714

THY/March 21, 2005